

Notice of Allowability	Application No.	Applicant(s)	
	10/766,263	MEESE ET AL.	
	Examiner	Art Unit	
	Zachary C. Tucker	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE 12 December 2005.
2. ☒ The allowed claim(s) is/are 50-63.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/700,094.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| <ol style="list-style-type: none"> 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>12Dec05,21Feb06</u> 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____. |
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EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The following amendments to the specification are necessary to render the instant application compliant with 37 CFR 1.77 (arrangement and contents of the specification) and 37 CFR 1.78(a)(1)(iv)(i) (cross-reference to related applications), and reflect the arrangement and contents of the specification of the parent application, 09/700,094. Applicants' preliminary amendment filed 27 January 2004 included a cross-reference to the parent application, serial number 09/700,094, but that application had not yet issued as a patent. The cross-reference to the parent application is restated hereinbelow, with added reference to the patent number of the parent application.

IN THE SPECIFICATION –

At page 1, under the title of the application, insert the following paragraph:

"The present application is a Continuation Application of USSN 09/700,094, filed January 2, 2001, now US Patent 6,713,464, which in turn claimed the priority benefit of PCT/EP99/03212, filed May 11, 1999."

Followed by the heading:

--BACKGROUND OF THE INVENTION--

At page 3, line 17 (before the paragraph that begins "It is an object...") insert the heading:

--SUMMARY OF THE INVENTION--

At page 4, starting at line 4 (BEFORE the paragraph beginning that begins "According to the present invention..." insert the following paragraph and headings:

--BRIEF DESCRIPTION OF THE DRAWING

FIG. 1 shows the formation of the active metabolite from different prodrugs by human liver S 9(%) in 1 hour.

DETAILED DESCRIPTION OF THE INVENTION--

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 C.F.R. 1.17(e), was filed in this application after allowance. Since this application is eligible for continued examination under 37 C.F.R. 1.114, and the fee set forth in 37 C.F.R. 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 C.F.R. 1.114.

Applicants' submissions of Information Disclosure Statements on 12 December 2005 and 21 February 2006 have been reviewed by the examiner.

Allowable Subject Matter

Claims 50-63 are allowed.

The reasons for indication of allowable subject matter remain the same as were explained in the Notice of Allowability mailed 10 May 2005, and can be found in that Office action.

The submission of the Information Disclosure Statement of 23 August 2005, with the Requested for Continued Examination under 37 C.F.R. 1.114 has been considered and none of the cited references are novelty-destroying or render obvious the claimed compounds, methods and compositions.

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Comment

On the PTO-1449 form accompanying the Information Disclosure Statement of 21 February 2006, the fourth U.S. patent application publication cited on the first page of that form, although cited correctly, with the correct inventor listed, does not pertain in any way to the present invention; it discloses some type of software used for publishing.

The fifth item cited on that same page, U.S. patent 3,216,841, to Zenitz, is improperly cited. US 3,216,841 does not name Zenitz as an inventor. That particular item has therefore been lined through.

Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312;

information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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